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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HAMZA, FARUK

ART UNIT PAPER NUMBER

2155

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/987,892

Applicant(s)

NAKAMURA, MITSUTAKA

Examiner

Faruk Hamza

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. This communication is responsive to the amendment filed on June 06, 2005. Claims 1-6 and 8-10 have been amended. Claim 11 has been newly added. Claims 1-11 are now pending.

***Claim Objections***

2. Claim 9 is objected to because of the following informalities: Claim 9 recites "a article". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specification does not support the claimed limitation of server accepting article to be delivered.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to examiner if article is physical or electronics. For the purpose of examination examiner interpreting article as electronics since server accepting it to be delivered.

Claim 4 recites the limitation "at said server". There is insufficient antecedent basis for this limitation in the claim.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear and indefinite what kind of message timing coordinating with parcels how said message is transmitted. Proper steps and processes are missing in the claim. It is unclear how recipient receive the message. Appropriate steps or processes are missing in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Lockhart et al. (U.S. Patent Number 6,732,152) hereinafter referred as Lockhart.

Lockhart teaches the invention as claimed including a method for generating and distributing mail items includes creating a first and a second mail file, where each of the first and second mail files includes recipient address information, the first and second mail files are then transmitted to a mail server computer over a global computer network (See abstract).

As to claim 1, Lockhart teaches a method for delivering messages, the method comprising:

accepting at a server an article to be delivered (Column 3, lines 46-57);

accepting at said server an electronic message by associating the electronic message with the article (Column 3, lines 46-Column 4, lines 8); and

sending from said server the electronic message associated with the article to a receiver of the article at the time of receiving notification at said server that delivery of the article is completed (Column 3, lines 46-Column 4, lines 30).

As to claim 2, Lockhart teaches a method for delivering messages, the method comprising:

accepting at a server an article to be delivered (Column 3, lines 46-57);

accepting at a server an electronic message by associating the electronic message with the article (Column 3, lines 46-57); and

sending from said server the electronic message associated with the article to a terminal of a deliverer who delivers the electronic message at a time of shipping the article to deliver (Column 1, lines 20-35).

As to claim 3, Lockhart teaches a method for delivering messages, the method comprising:

accepting information at a server regarding an article to be delivered and an electronic message associated with the article from a server (Column 3, lines 46-57); and

sending from said server the electronic message associated with the article to a receiver of the article at a time of accepting input which indicates that delivery of the article is completed (Column 3, lines 46-Column 4, lines 30).

As to claim 4, Lockhart teaches a method for delivering messages, the method comprising:

accepting at said server an article to be delivered (Column 3, lines 46-57);

accepting an electronic message by associating the electronic message with the article (Column 3, lines 46-Column 4, lines 8); and

permitting updating the electronic message associated with the article before receiving notification that delivery of the article is completed (Column 3, lines 46-Column 4, lines 30).

As to claim 5, Lockhart teaches a program executed on a computer for delivering messages, the program comprising:

a section for causing the computer to function as a unit for accepting an article to be delivered (Column 3, lines 46-Column 4, lines 30);

a section for causing the computer to function as a unit for accepting an electronic message by associating the electronic message with the article (Column 3, lines 46-Column 4, lines 30); and

a section for causing the computer to function as a unit for sending the electronic message associated with the article to a receiver of the article at the time of receiving notification that delivery of the article is completed (Column 3, lines 46-Column 4, lines 30).

As to claim 6, Lockhart teaches a program executed on a computer for delivering messages, the program comprising:

a section for causing the computer to function as a unit for accepting an article to be delivered (Column 3, lines 46-Column 4, lines 30);

a section for causing the computer to function as a unit for accepting an electronic message by associating the electronic message with the article (Column 3, lines 46-Column 4, lines 30); and

a section for causing the computer to function as a unit for sending the electronic message associated with the article to a terminal of a deliverer at the time of shipping the article to deliver (Column 3, lines 46-Column 4, lines 30).

As to claim 7, Lockhart teaches a program executed on a computer for delivering messages, the program comprising:

a section for causing the computer to function as a unit for accepting information regarding an article to be delivered and an electronic message associated with the article from a server (Column 3, lines 46-Column 4, lines 30); and

a section for causing the computer to function as a unit for sending the electronic message associated with the article to a receiver of the article at the time of accepting input which indicates that delivery of the article is completed (Column 3, lines 46-Column 4, lines 30).



As to claim 8, Lockhart teaches a program executed on a computer for delivering messages, the program comprising:

a section for causing the computer to function as a unit for accepting an article to be delivered (Column 3, lines 46-Column 4, lines 30);

a section for causing the computer to function as a unit for accepting an electronic message by associating the electronic message with the article (Column 3, lines 46-Column 4, lines 30); and

a section for causing the computer to function as a unit for permitting updating the electronic message associated with the article before receiving notification that delivery of the article is completed (Column 3, lines 46-Column 4, lines 30).

As to claim 9, Lockhart teaches a unit for delivering messages, the unit comprising:

a section for accepting information regarding an article to be delivered and an electronic message associated with the article from a server (Column 3, lines 46-Column 4, lines 30); and

a section for sending the electronic message associated with the article to a receiver of a article at a time of accepting input which indicates that delivery of the article is completed (Column 3, lines 46-Column 4, lines 30).

As to claim 10, Lockhart teaches a method for delivering messages, the method comprising:

sending an identifier for an article delivery of which is requested and an electronic message directed to a receiver of the article to a server (Column 3, lines 46-Column 4, lines 30);

sending the server a request to update the electronic message sent (Column 3, lines 46-Column 4, lines 30); and

causing the server to update the electronic message based on the sent request in a case in which the server judges delivery of the article as being incomplete, said article being associated in the server with an identifier included in the request for update (Column 3, lines 46-Column 4, lines 30).

As to claim 11, Lockhart teaches a method for coordinating timing of message with corresponding parcels, comprising:

transmitting a message to be delivered to a recipient (Column 1, lines 20-35; Column 3, lines 46-Column 4, lines 30); and

allowing the recipient to receive the message at a time equal to or after a time at which a parcel corresponding to the message is delivered to the recipient (Column 1, lines 20-35; Column 3, lines 46-Column 4, lines 30).

***Conclusion***

6. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faruk Hamza whose telephone number is 571-272-7969. The examiner can normally be reached on Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll -free).

Faruk Hamza

Patent Examiner

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